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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): HELOT et al.

Confirmation No.: 1876

Application No.: 09/439,626

Examiner: Cuff, Michael A.

Filing Date: November 12, 1999

Group Art Unit: 3627

Title: A SYSTEM AND METHOD FOR ORDERING CONSUMER ITEMS IN ELECTRONIC COMMERCE

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on May 19, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: HELOT et al. Confirmation No.: 1876

Serial No.: 09/439,626

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Docket No.: 10991266-4

MAIL STOP: APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Applicants respectfully submit this Reply Brief in response to the Examiner's Answer mailed May 19, 2006, pursuant to 37 C.F.R. § 1.193(b).

STATUS OF CLAIMS

Claims 1-28 were canceled without prejudice or disclaimer, Claims 49-56 are considered withdrawn as being directed toward a non-elected species, and Claims 29-48 stand rejected pursuant to a Final Office Action mailed November 2, 2005. Claims 29-48 are presented for appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 29-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,331,858 issued to Fisher (hereinafter "*Fisher*") in view of non-patent document "JavaScript Image Rollovers" by Taylor (hereinafter "*Taylor*").

ARGUMENT1. First Ground of Rejection (Claims 29-48)

Claims 29-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Fisher* in view of *Taylor*. Of these claims, Claims 29, 36 and 42 are independent.

In the Examiner's Answer, the Examiner appears to indicate that the Examiner considers items 301-303 of *Fisher* to correspond to the "consumer item" recited by Claim 29, and that the Examiner considers the fabric samples of *Fisher* as corresponding to the "option associated with the consumer item" recited by Claim 29 (Examiner's Answer, page 3). As discussed in Applicants' Appeal Brief, *Fisher* does not disclose or even suggest any other option depending on a selection of a fabric sample of the *Fisher* system, let alone "indicat[ing] to [a] user unavailability of at least one other option associated with the consumer item based on the update to the consumer item" as recited by Claim 29 (emphasis added). In the Examiner's Answer, the Examiner states: "Finish options depend on the previously selected option on which item was chosen." (Examiner's Answer, page 3). The Examiner also states:

In reviewing the rejection the examiner regrets not being more clear about what was considered to be the "at least one other option". It is the texture data. The texture data is mapped one-to-one with the fabrics, but there are many of them and they are options.

(Examiner's Answer, page 6). Applicants respectfully disagree. The Examiner appears to be relying on the following recited by *Fisher*:

The user can select the fabric to be applied, for example to the chair, by clicking on the chair marker beside the fabric sample. The HTML document includes Javascript which detects the selection made by the user and sets the relevant marker parameter to a value which depends on which fabric was selected. The marker value is returned to the Viscape application where it is used to address an index of URL's (uniform resource locators) corresponding to texture data for different fabrics. A connection to the selected URL is then opened and the relevant texture file is downloaded and

mapped onto the relevant object using the Lsprite function, as described previously. The display of the 3D scene is immediately updated, so that the chair is shown finished in the newly selected fabric.

(*Fisher*, column 4, lines 30-44). Thus, Applicants respectfully submit that the “texture data” of *Fisher* which the Examiner appears to be relying on to reject Claim 29 is not an “option” at least because the user of the *Fisher* system has no control to select any such texture to be applied to the selected fabric much less indicating the unavailability of any “texture data” based on a user’s fabric selection. To the contrary, the Examiner appears to acknowledge that a one-to-one relationship exists between the texture data and the fabric selected (Examiner’s Answer, page 6). In fact, *Fisher* appears to clearly disclose that based on the fabric selected by the user of the *Fisher* system, the texture is automatically retrieved and applied. Thus, Applicants respectfully submit that the “texture data” of *Fisher* relied on by the Examiner is not an “option.”

Further, the Examiner asserts that with respect to the “texture data” of *Fisher*, “there are many of them and they are options” (Examiner’s Answer, page 6). Applicants respectfully submit that *Fisher* does not disclose or even suggest that for a particular fabric selection in the *Fisher* system that there are “many of them” (texture data) to be applied to the selected fabric. To the contrary, *Fisher* appears to disclose that there is only a single texture for any particular selected fabric. Moreover, *Fisher* appears to disclose that the retrieval and application of the “texture data” of *Fisher* is performed in the *Fisher* system invisible to the user. Thus, *Fisher* does not disclose or even suggest, nor has the Examiner explicitly identified any disclose in the *Fisher* reference, that there is any indication in *Fisher* of which textures are available or much less which other textures are unavailable based on the selected fabric in *Fisher*. Further, *Taylor* does not remedy these deficiencies of *Fisher*.

Thus, Applicants respectfully submit that the “texture data” of *Fisher* is not an “option” as asserted by the Examiner. Further, even if the “texture data” of *Fisher* is considered an option, which Applicants respectfully disagree, at least because there is only one texture for any selected fabric in *Fisher*, *Fisher* does not disclose or even

suggest that there is an indication of what other textures are available, much less which textures are unavailable, especially because there are no other textures available for the selected fabric in *Fisher*. Further, *Fisher* does not disclose or even suggest that there is an indication of what textures are unavailable based on a fabric selected by a user of the *Fisher* system. Moreover, because the retrieval and application of the texture to the fabric selected in *Fisher* is performed invisibly to the user in the *Fisher* system, there is no indication to a user of the *Fisher* system as to the unavailability of any other textures. *Taylor* does not remedy at least these deficiencies of *Fisher*. Thus, for at least these reasons, Claim 29 is patentable over the cited references.

The Examiner also appears to assert that because independent Claim 29 recites the phrase “adapted to” (e.g., “a presentation module adapted to provide a real-time preview . . . [and] adapted to indicate to the user unavailability of at least one other option” (emphasis added)), such claim language does not limit the scope of Claim 29 (Examiner’s Answer, page 5 (referring to M.P.E.P. § 2111.04)). The Examiner appears to arbitrarily conclude that if a claim contains the phrase “adapted to,” such recitation automatically has no limiting effect. Applicants respectfully point out that M.P.E.P. § 2111.04 recites:

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.”

(emphasis added). Applicants respectfully submit that the phrase “adapted to” recited by Claim 29 imposes a limitation that must be met by any prior art reference(s) cited by the Examiner and, in the instant case, *Fisher* is clearly deficient.

Independent Claim 36 recites “providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option” and “indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the

consumer item" (emphasis added), and independent Claim 42 recites "means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option" and "means for indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item" (emphasis added). At least for the reasons discussed above in connection with independent Claim 29, Applicants respectfully submit that independent Claims 36 and 42 are patentable over the cited references. For example, neither *Fisher* nor *Taylor*, alone or in combination, discloses, teaches or suggests "indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item" as recited by Claim 36 and 42. Accordingly, Claims 36 and 42 are also patentable over the cited references.

In the Examiner's Answer, the Examiner also appears to indicate that the Examiner considers the validation of a selected fabric for a particular consumer item as corresponding to "indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item" as recited by Claim 36 (Examiner's Answer, unnumbered page between pages 5 and 6). Applicants respectfully disagree. *Fisher* appears to disclose that the *Fisher* system checks to determine whether the selected fabric is valid for a particular consumer item (*Fisher*, column 6, lines 7-13). Accordingly, *Fisher* also appears to indicate that if the selected fabric is not valid for the particular consumer item, it is unnecessary to retrieve any texture data (*Fisher*, column 6, lines 13-15). Thus, *Fisher* does not appear to disclose or even suggest that there is any indication to the user of the *Fisher* system as to the unavailability of any particular texture. To the contrary, the only information that appears to be provided to the user of the *Fisher* system is that the selected fabric is not valid for the particular consumer item. Moreover, if the selected fabric is not valid for particular consumer item, there cannot be in *Fisher* a "real-time preview representation of the consumer item updated with the option" as recited by Claim 36. Therefore, for at least these reasons also, Claim 36 is patentable over the cited references.

Therefore, for at least the reasons discussed above, independent Claims 29, 36 and 42 are clearly patentable over *Fisher* in view of *Taylor*. Thus, Claims 29, 36 and 42, and Claims 30-35, 37-41 and 43-48 that depend respectively therefrom, are in condition for allowance.

CONCLUSION

Applicants have demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

No fee is believed due with this Reply Brief. If, however, Applicants have overlooked the need for any fee, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,



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